



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,311	11/27/2001	James R. Shay	021737-001410US	3014

20350 7590 10/20/2006

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

WASSUM, LUKE S

ART UNIT PAPER NUMBER

2167

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/997,311

Applicant(s)

SHAY ET AL.

Examiner

Luke S. Wassum

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7, 8, 10-14 and 17-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 10-14 and 17-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20060626.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Applicants' amendment, filed 12 September 2006, has been received, entered into the record, and considered.
2. As a result of the amendment, claims 6, 9, 15 and 16 have been canceled, and claims 1, 7, 10, 12, 14, 17, 18, 20, 25, 32, 34 and 35 have been amended. Claims 1-5, 7, 8, 10-14 and 17-37 remain pending in the application.

### ***The Invention***

3. The claimed invention is a method for preparing documents for submission to a patent office; wherein the documents are automatically locked upon receipt of a first signal, and further wherein said documents are converted into locked image files in response to receipt of a second signal.

### ***Priority***

4. The Applicants' claim to domestic priority under 35 U.S.C. § 119(e) based upon U.S. Provisional Applications 60/309,244, filed 31 July 2001, and 60/253,360, filed 27 November 2000, is acknowledged.

5. Since the relevant features (specifically, the locking of the electronic documents upon receipt of the first signal from the user) appear to be supported only by the '244' application, the instant application is entitled to a priority date of 31 July 2001.

*Information Disclosure Statement*

6. The Applicants' Information Disclosure Statement, filed 23 June 2006, has been received and entered into the record. The Information Disclosure Statement complies with the provisions of MPEP § 609, with the following exceptions: document C10 is identical to document C11 and has not been considered; document C13 is a subset of document C14, and has not been considered; document C15 is a subset of document C16, and has not been considered. The remaining references cited therein have been considered by the examiner. See attached form PTO-1449.

The examiner notes that many of the non-patent documents cited on the Applicants' IDS are Office actions for other patent applications. Although they have been considered by the examiner, the Applicants are advised that such documents have no bearing on the prosecution of the instant application.

*Claim Rejections - 35 USC § 112*

7. In view of the cancellation of claim 15, the examiner withdraws the pending claim rejections under 35 U.S.C. § 112.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claim 8, this claim depends from canceled claim 6.

*Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 2167

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1-5, 8, 10-14, 18-28 and 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Horikawa et al.** (European Patent Application 0,495,983 A1) in view of **Cautley et al.** (U.S. Patent Application Publication 2002/0065697) in view of **Britton** (U.S. Patent 6,591,289).

15. Regarding claim 1, **Horikawa et al.** teaches a computer-implemented method of controlling document edits substantially as claimed, comprising:

- a) storing a plurality of alterable electronic documents on a computer system, the plurality of electronic documents being associated with a patent application (see Figure 6A, et seq., displaying the document table containing said plurality of documents associated with a patent application); and
- b) receiving from a user a first signal indicating that one or more of the electronic documents are ready to be filed in a patent office (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16); and
- c) receiving from the user a second signal indicating that the documents are filed in the patent office (see disclosure of transmission status, page 28, lines 26-30; see also drawing Figure 50).

**Horikawa et al.** does not explicitly teach a computer-implemented method wherein the one or more electronic documents are automatically locked.

**Cautley et al.**, however, teaches a computer-implemented method including automatically locking the one or more electronic documents into a non-editable form upon receiving a first signal from a user (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).



Neither **Horikawa et al.** nor **Cautley et al.** explicitly teaches a computer-implemented method including the step of automatically converting the one or more electronic documents from a first document type to a locked image file in response to receiving a signal indicating that the documents have been filed with the patent office.

**Britton**, however, teaches the conversion of files from a first document type into a pdf formatted file (see col. 2, line 53 through col. 3, line 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to convert the document to a pdf formatted file, since this creates a permanently non-alterable version of the file in that a user is allowed to view the file in the Adobe Acrobat Reader program, but the user is not allowed to make changes to the file (see col. 2, line 53 through col. 3, line 9), said permanently non-alterable version of the document allowing for the preservation of a copy of any documents filed as part of a patent application, which would be necessary in order to be able to properly respond to any communications regarding said patent application from the patent office.

16. Regarding claim 12, **Horikawa et al.** teaches a computer-implemented method of controlling document edits substantially as claimed, comprising:

- a) storing a plurality of alterable electronic documents on a computer system, the plurality of electronic documents being associated with a patent application (see Figure 6A, et seq., displaying the document table containing said plurality of documents associated with a patent application);
- b) creating a package including one or more of the electronic documents, the package being displayed in a first folder of a graphical user interface (see screenshot of the package 'Hand Scanner', containing 4 documents, Figure 18);
- c) receiving from a user a first signal indicating that the package has been transferred from a first phase to a second phase (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16); and
- d) receiving from a user a second signal indicating that the package has been transferred from a second phase to a third phase (see disclosure of transmission status, page 28, lines 26-30; see also drawing Figure 50).

**Horikawa et al.** does not explicitly teach a computer-implemented method wherein the one or more electronic documents are automatically locked.

**Cautley et al.**, however, teaches a computer-implemented method including automatically locking the one or more electronic documents into a non-editable form upon receiving a first signal from a user (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

Neither **Horikawa et al.** nor **Cautley et al.** explicitly teaches a computer-implemented method including the step of automatically converting the one or more electronic documents from a first document type to a locked image file in response to receiving a signal indicating that the documents have been filed with the patent office.

**Britton**, however, teaches the conversion of files from a first document type into a pdf formatted file (see col. 2, line 53 through col. 3, line 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to convert the document to a pdf formatted file, since this creates a permanently non-alterable version of the file in that a user is allowed to view the file in the Adobe Acrobat Reader program, but the user is not allowed to make changes to the file (see col. 2, line 53 through col. 3, line 9), said permanently non-alterable version of the document allowing for the preservation of a copy of any documents filed as part of a patent application, which would be necessary in order to be able to properly respond to any communications regarding said patent application from the patent office.

17. Regarding claim 20, **Horikawa et al.** teaches a computer-implemented method of controlling document edits substantially as claimed, comprising:

- a) storing a plurality of electronic documents on a computer system, each electronic document having a native format type (see disclosure that the system comprises a document conversion part which converts document data of various kinds of formats into the data of the document format of the terminal, Abstract, page 1; see also various native formats, elements 1, 2, 3 in drawing Figure 1);
- b) creating a package including one or more of the electronic documents (see screenshot of the package 'Hand Scanner', containing 4 documents, Figure 18); and
- c) receiving from a user a first signal indicating that a package is ready to be filed in a patent office (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16); and
- d) receiving from the user a second signal indicating that the package has been filed in the patent office (see disclosure of transmission status, page 28, lines 26-30; see also drawing Figure 50).

**Horikawa et al.** does not explicitly teach a computer-implemented method wherein the one or more electronic documents are automatically locked.

**Cautley et al.**, however, teaches a computer-implemented method including automatically locking the one or more electronic documents into a non-editable form upon receiving a first signal from a user (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

Neither **Horikawa et al.** nor **Cautley et al.** explicitly teaches a computer-implemented method including the step of in response to a second signal, automatically converting the one or more electronic documents from a first document type to a locked image file in response to receiving a signal indicating that the documents have been filed with the patent office and displaying said file to a remote user.

**Britton**, however, teaches the conversion of files from a first document type into a pdf formatted file and displaying said file to a remote user (see col. 2, line 53 through col. 3, line 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to convert the document to a pdf formatted file, since this creates a permanently non-alterable version of the file in that a user is allowed to view the file in the Adobe Acrobat Reader program, but the user is not allowed to make changes to the file (see col. 2, line 53 through col. 3, line 9), said permanently non-alterable version of the document allowing for the preservation of a copy of any documents filed as part of a patent application, which would be necessary in order to be able to properly respond to any communications regarding said patent application from the patent office.

18. Regarding claim 32, **Horikawa et al.** teaches a computer system for controlling document edits, the computer system comprising a processor and a computer readable medium substantially as claimed, comprising instructions executable by the processor to:

- a) store a plurality of alterable electronic documents on a computer system, the plurality of electronic documents being associated with a patent application (see Figure 6A, et seq., displaying the document table containing said plurality of documents associated with a patent application);
- b) receive from a user a first signal indicating that one or more of the electronic documents are to be filed in a patent office (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16); and
- c) receive from the user a second signal indicating that the electronic documents are filed in the patent office (see disclosure of transmission status, page 28, lines 26-30; see also drawing Figure 50).

**Horikawa et al.** does not explicitly teach a computer system wherein the one or more electronic documents are automatically locked.



**Cautley et al.**, however, teaches a computer system including automatically locking the one or more electronic documents into a non-editable form upon receiving a first signal from a user (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

Neither **Horikawa et al.** nor **Cautley et al.** explicitly teaches a computer system including instructions for automatically converting the one or more electronic

documents from a first document type to a locked image file in response to receiving a signal indicating that the documents have been filed with the patent office.

**Britton**, however, teaches the conversion of files from a first document type into a pdf formatted file (see col. 2, line 53 through col. 3, line 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to convert the document to a pdf formatted file, since this creates a permanently non-alterable version of the file in that a user is allowed to view the file in the Adobe Acrobat Reader program, but the user is not allowed to make changes to the file (see col. 2, line 53 through col. 3, line 9), said permanently non-alterable version of the document allowing for the preservation of a copy of any documents filed as part of a patent application, which would be necessary in order to be able to properly respond to any communications regarding said patent application from the patent office.

19. Regarding claim 34, **Horikawa et al.** teaches a computer program embodied on a computer readable medium substantially as claimed, the computer program comprising instructions executable by the computer to:

- a) store a plurality of alterable electronic documents on a computer system, the plurality of electronic documents being associated with a patent application (see Figure 6A, et seq., displaying the document table containing said plurality of documents associated with a patent application);
- b) receive from a user a first signal indicating that one or more of the electronic documents are to be filed in a patent office (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16); and
- c) receive from the user a second signal indicating that the electronic documents are filed in the patent office (see disclosure of transmission status, page 28, lines 26-30; see also drawing Figure 50).

**Horikawa et al.** does not explicitly teach a computer program wherein the one or more electronic documents are automatically locked.

**Cautley et al.**, however, teaches a computer program including automatically locking the one or more electronic documents into a non-editable form upon receiving a first signal from a user (see disclosure that upon formal submission of a proposal, the

system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

Neither **Horikawa et al.** nor **Cautley et al.** explicitly teaches a computer program including instructions for automatically converting the one or more electronic documents from a first document type to a locked image file in response to receiving a signal indicating that the documents have been filed with the patent office.

**Britton**, however, teaches the conversion of files from a first document type into a pdf formatted file (see col. 2, line 53 through col. 3, line 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to convert the document to a pdf formatted file, since this creates a permanently non-alterable version of the file in that a user is allowed to view the file in the Adobe Acrobat Reader program, but the user is not allowed to make changes to the file (see col. 2, line 53 through col. 3, line 9), said permanently non-alterable version of the document allowing for the preservation of a copy of any documents filed as part of a patent application, which would be necessary in order to be able to properly respond to any communications regarding said patent application from the patent office.

20. Regarding claim 35, **Horikawa et al.** teaches a method of electronically filing a document in a patent office substantially as claimed, the method comprising:

- a) storing a document on a computer system, wherein the document is associated with a patent application (see Figure 6A, et seq., displaying the document table containing said plurality of documents associated with a patent application);

- b) allowing a user to edit the document (see text editing portion 8 in drawing Figure 1);
- c) receiving a first signal from a user indicating that the document is ready to be filed in a patent office (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16);
- d) receiving from the user a second signal indicating filing of the document with the patent office (see disclosure of transmission status, page 28, lines 26-30; see also drawing Figure 50); and
- e) electronically filing the document with a patent office via an interface to an electronic filing system of the patent office (see disclosure of the transmission of the application to the patent office, page 28, lines 17-22 et seq.).

**Horikawa et al.** does not explicitly teach a method wherein the document is automatically locked in response to the first signal.

**Cautley et al.**, however, teaches a method including automatically locking the one or more electronic documents into a non-editable form upon receiving a first signal

from a user (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

Neither **Horikawa et al.** nor **Cautley et al.** explicitly teaches a method including the step of in response to a second signal, automatically converting the one or more electronic documents from a first document type to a second document type in response to receiving a signal indicating filing of the document with the patent office.

**Britton**, however, teaches the conversion of files from a first document type into a pdf formatted file (see col. 2, line 53 through col. 3, line 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to convert the document to a pdf formatted file, since this creates a permanently non-alterable version of the file in that a user is allowed to view the file in the Adobe Acrobat Reader program, but the user is not allowed to make changes to the file (see col. 2, line 53 through col. 3, line 9), said permanently non-alterable version of the document allowing for the preservation of a copy of any documents filed as part of a patent application, which would be necessary in order to be able to properly respond to any communications regarding said patent application from the patent office, and furthermore because a pdf formatted file would allow electronic transmission and display of a file in a non-alterable format.

21. Regarding claims 2 and 37, **Horikawa et al.** additionally teaches a method further comprising storing the one or more electronic documents in a package prior to generating the first signal and filing said package electronically (see screenshot of the package 'Hand Scanner', containing 4 documents, Figure 18).



22. Regarding claim 3, **Cautley et al.** additionally teaches a method further comprising allowing a user to perform manual verification of the locked electronic documents prior to filing the documents in the patent office (see disclosure that the documents can be routed to one or more reviewers, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to allow a document to be reviewed before formally submitted, since this would allow a final verification that the contents of the document is correct (see paragraph [0005]), especially important when filing official documents such as project proposals or patent applications.

23. Regarding claims 4 and 26-28, **Horikawa et al.** additionally teaches a method further comprising electronically filing the electronic documents in the patent office including transmitting the electronic documents to the patent office via an interface to an electronic filing system of the patent office (see disclosure of the transmission of the application to the patent office, page 28, lines 17-22 et seq.).

24. Regarding claim 5, **Cautley et al.** additionally teaches a method further comprising generating a first lock signal in response to the first signal, and in accordance therewith, automatically locking the one or more electronic documents (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

25. Regarding claim 8, **Britton** additionally teaches the conversion of files from a first document type into a pdf formatted file (see col. 2, line 53 through col. 3, line 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to convert the document to a pdf formatted file, since this allows a user to view the file in the Adobe Acrobat Reader program, without allowing the user to make changes to the file (see col. 2, line 53 through col. 3, line 9).

26. Regarding claims 10 and 18, **Horikawa et al.** additionally teaches a method wherein each electronic document has a native format type (see disclosure of the merging of multiple text and image files, page 22, line 31 through page 24, line 18; see also drawing Figures 36-38).

27. Regarding claims 11, 19 and 36, **Horikawa et al.** additionally teaches a method wherein the electronic documents include a provisional patent application specification, non-provisional patent application specification, response to an Office action, inventor declaration, assignment, power of attorney or patent drawings (see illustration of different document types, left column of the document table in drawing Figure 6A).

28. Regarding claim 13, **Cautley et al.** additionally teaches a method wherein the first phase is a final draft phase and the second phase is a ready to file phase (see

disclosure of the project submission phase 34, analogous to the final draft phase, and the document review decision/version project phase 42-45-50, analogous to the ready to file phase, in drawing Figure 3).

29. Regarding claim 14, **Horikawa et al.** additionally teaches a method wherein the first phase is a final draft phase and the third phase is a filed phase (see disclosure that the operator selects a transmission file generation mode, signaling the intention to file the application with a patent office, page 28, lines 14-16; see also disclosure of the transmission of the application to the patent office, page 28, lines 17-22 et seq.).

30. Regarding claim 21, **Cautley et al.** additionally teaches a method further comprising locking the transformed one or more documents (see disclosure that upon formal submission of a proposal, the system freezes the proposal, thus locking out any changes to the submitted proposal documents by the proposer or anyone else, paragraph [0043]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the feature of document locking from the **Cautley et al.** reference into the patent submission system of **Horikawa et al.**, since freezing

submitted patent documents would ensure that the applicant preserved a copy of any documents submitted to the patent office, which would be necessary in order to be able to properly respond to any communications regarding said submitted documents from the patent office (see disclosure in the Abstract of the **Cautley et al.** reference that submitted proposals are frozen so that subsequent reviews are conducted based upon the version of the proposal as submitted).

31. Regarding claim 22, **Horikawa et al.** additionally teaches a method further comprising generating a signal indicating that the package can be filed (see disclosure that the disk capacity must be sufficient to hold the package before the package can be transmitted, page 28, lines 48-59; see also drawing Figure 48, wherein the steps embodied in drawing elements SM5, SM6 and SM7 are analogous to the claimed signal, since these steps occur only if there is sufficient disk capacity to store the package to be transmitted).

32. Regarding claim 23, **Britton** additionally teaches the transmission of files over a network via email (see col. 2, lines 53-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to transmit documents via email, since email has become a common and efficient method of transferring documents electronically, thus saving the time and expense of transmitting documents in paper form (see col. 2, lines 53-59).

33. Regarding claim 24, **Horikawa et al.** additionally teaches electronically filing the package in a patent office (see disclosure of the transmission of the application to the patent office, page 28, lines 17-22 et seq.).

34. Regarding claim 25, **Cautley et al.** additionally teaches a method further comprising prior at receiving a second signal, receiving a signal indicating that the one or more electronic documents needs to be edited, and automatically unlocking the one or more documents into an editable form (see disclosure that if the proposal is not approved, the system unfreezes the proposal to allow revision, paragraph [0007]).

35. Regarding claim 31, **Horikawa et al.** additionally teaches a method further comprising electronically filing the electronic documents in the patent office including transmitting the electronic documents to the patent office via an interface to an

electronic filing system of the patent office (see disclosure of the transmission of the application to the patent office, page 28, lines 17-22 et seq.).

36. Regarding claim 33, **Horikawa et al.** additionally teaches a computer readable medium wherein at least one of the plurality of documents is stored on a second computer system, and wherein the computer readable medium comprises further instructions executable by the processor to load the at least one of the plurality of documents from the second computer system onto the computer system prior to locking the one or more of the electronic documents (see transfer of files from second computer system via floppy disks 14, 15, 16 in drawing Figure 1).

37. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Horikawa et al.** (European Patent Application 0,495,983 A1) in view of **Cautley et al.** (U.S. Patent Application Publication 2002/0065697) in view of **Britton** (U.S. Patent 6,591,289) as applied to claims 1-5, 8, 10-14, 18-28 and 31-37 above, and further in view of **Haff et al.** (U.S. Patent Application 6,219,669).

38. Regarding claims 7 and 17, **Horikawa et al.**, **Cautley et al.** and **Britton** teach a computer-implemented method of controlling document edits substantially as claimed.

None of **Horikawa et al.**, **Cautley et al.** nor **Britton** explicitly teaches a method further comprising displaying the locked image files in a file history portion of a graphical user interface providing a record of documents submitted to a patent office.

**Haff et al.**, however, teaches an event log window which displays records of all transmitted files that have been sent or received (see drawing Figure 15; see also col. 8, lines 8-16; see also col. 21, lines 46-53; see also col. 37, lines 41-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention to maintain a log that tracked which documents had been transmitted from the system, since the logging of file/document transmission is important in maintaining system accountability, allowing a system administrator to determine when and if specific documents have been transmitted from the system, and where said documents were sent.



39. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Horikawa et al.** (European Patent Application 0,495,983 A1) in view of **Cautley et al.** (U.S. Patent Application Publication 2002/0065697) in view of **Britton** (U.S. Patent 6,591,289) as applied to claims 1-5, 8, 10-14, 18-28 and 31-37 above, and further in view of **Scott et al.** (U.S. Patent 6,489,980).

40. Regarding claims 29 and 30, **Horikawa et al.**, **Cautley et al.** and **Britton** teach a computer-implemented method of controlling document edits substantially as claimed.

None of **Horikawa et al.**, **Cautley et al.** nor **Britton** explicitly teaches a method wherein the first signal comprises the user moving a document from a first section of a graphical user interface to a second section of a graphical user interface.

**Scott et al.**, however, teaches the uploading and downloading of files through the use of a 'drag and drop' user interface (see col. 5, lines 55-57; see also col. 6, lines 45-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a drag and drop interface to initiate the transmission of files across a network, since this type of user interface has been found to be very intuitive and simple to use, and has been in use in the user interface art for well over a decade.

### *Response to Arguments*

41. Applicant's arguments filed 12 September 2006 have been fully considered but they are not persuasive.

42. Regarding the Applicants' argument that the prior art of record fails to teach locking one or more electronic documents in response to a first signal indicating the documents are ready to file or converting electronic documents into a locked image file in response to a second signal indicating filing of the documents, the examiner respectfully disagrees.

The combination of the **Horikawa et al.**, **Cautley et al.** nor **Britton** references teaches the cited limitation, as is clearly disclosed in the rejections of record. In summary, **Horikawa et al.** teaches a system for managing patent documents and electronically filing said documents with the patent office. **Cautley et al.** teaches a

system for managing and submitting project proposals, including the feature of locking a proposal when it is ready to be filed, in order to preserve a copy of the as-submitted proposal so that a clear record can be maintained of the state of the proposal at the time it was submitted. **Britton** teaches the advantages of converting documents to a read-only pdf format. The rejections of record provide citations and motivations for combining features from each reference. The rejections of record are maintained.

### *Conclusion*

43. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

**Atluri et al.** ("An Authorization Model for Workflows") teaches a system that enforces security policies, specifically wherein in the context of a workflow that represents a document release process, which consists of the task of a scientist preparing a document and the task of getting approval from the patent officer of his organization, the scientist will have all rights on the document during the document preparation task, but the scientists' write privilege to the document will be revoked as soon as he submits the document for approval (see page 2, third paragraph).

44. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

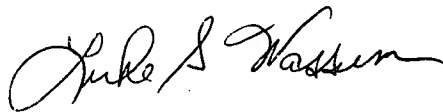
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Luke S. Wassum  
Primary Examiner  
Art Unit 2167

lsw  
9 October 2006